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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,111	02/15/2002	C. Gordon Todderud	D0031 NP	1564

7590 03/09/2004

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EXAMINER	
ZARA, JANE J	

ART UNIT	PAPER NUMBER
1635	

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/077,111	TODDERUD ET AL.	
	Examiner	Art Unit	
	Jane Zara	1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 February 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-20* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ ~~Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)~~ Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-20 are pending in the instant application.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-4, 7, 8, 15-17 and 20, drawn to compositions and methods comprising nucleic acids, classified in class 435, subclass 6.

II. Claims 5 and 18, drawn to polypeptides, classified in class 530, subclasses 300 and 350.

III. Claims 6, drawn to antibodies, classified in class 530, subclass 387.1.

IV. Claim 9, drawn to a method to screen for specific binding molecules, classified in class 435, subclass 6.

V. Claim 10, drawn to a method to screen for modulators of a cell signal protein, classified in class 435, subclass 3.

VI. Claims 11, 12 and 19, drawn to methods of treating inflammation, classified in class 514, subclass 2.

VII. Claim 13, drawn to methods of screening for binding inhibitors of a second cell signaling protein, classified in class 435, subclass 3.

VIII. Claim 14, drawn to a method of identifying inhibitors of phosphorylation, classified in class 435, subclass 4.

Please elect a single nucleic acid or polypeptide sequence for Groups I and II, for the reasons set forth below. Additionally, Applicants are required to elect a human or mouse nucleic acid consistent with the elected SEQ ID NO.

Pursuant to 35 U.S.C. 121 and 37 C.F.R. 1.141, the nucleotide and polypeptide sequences listed in claims 1, 5, 15, 18 and 20 are subject to restriction. As per M.P.E.P. 2434, "the Commissioner has partially waived the requirements of 37 C.F.R. 1.141 and will permit a reasonable number of such nucleotide or amino acid sequences to be claimed in a single application." Under this policy, in most cases, up to 1 (one) independent and distinct nucleotide OR polypeptide sequence will be examined in a single application without restriction. Those sequences which are patentably indistinct from the sequence selected by the applicant will also be examined.

Claims 1, 5, 15, 18 and 20 specifically claim nucleotide or polypeptide sequences encoding cell signaling polypeptides, fragments or antisense, and these individual SEQ ID Nos. are listed in claims 1, 5, 15, 18 and 20. Each of these sequences is considered to be structurally independent, because each of these sequences has a unique nucleotide or polypeptide sequence, or each target a specific region of a cell signaling polynucleotide or fragment of the polypeptide. Furthermore, a search of all the sequences claimed presents an undue burden on the Patent and Trademark Office to search and examine all of the recited sequences. In view of the foregoing, applicants are required to elect up to 1 claimed nucleotide or polypeptide sequence from the claim.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-III and IV-VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are biologically and functionally different and distinct and one does not render the other obvious. The operation and function of the products of Groups I-III are completely different and distinct from the operation, function and effects of the methods of Groups IV-VIII, which encompass treatment and screening for a number of cellular processes and conditions in animals. Therefore, the inventions of the different and distinct groups are capable of supporting separate patents.

Inventions I and II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are biologically, chemically, structurally and functionally distinct from each other and thus one does not render the other obvious. The nucleic acids of Group I are not required to produce the polypeptides of Group II, or the antibodies of Group III, and vice versa. Therefore, the inventions of these different and distinct groups are capable of supporting separate patents.

Inventions I and IV and V and VI and VII and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP §

806.04, MPEP § 808.01). In the instant case the different inventions are biologically and functionally different and distinct from each other and thus one does not render the other obvious. The methods of Groups I, IV-VIII comprise steps which are not required for or present in the methods of the other groups: detecting hybridization of a polynucleotide of Group I, screening for specific binding molecules (Group IV), screening for modulators of cell signal proteins (Group V), treating inflammation (Group VI), screening for binding inhibitors of a second cell signaling protein (Group VII) and identifying inhibitors of phosphorylation (Group VIII). Thus, the operation, function and effects of these different methods are different and distinct from each other. Therefore, the inventions of these different, distinct groups are capable of supporting separate patents.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Certain papers related to this application may be submitted to Art Unit 1635 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone number for the Group is **703-872-9306**. NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jane Zara** whose telephone number is **(571) 272-0765.** If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader, can be reached on (571) 272-0760. Any inquiry regarding this application should be directed to the patent analyst, Katrina Turner, whose telephone number is (571) 272-0564. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

RAM R. SHUKLA, PH.D.
PRIMARY EXAMINER

JZ
2-25-04